## REMARKS

Claims 1-11 remain pending in this application. Claims 12-20 are newly added.

In rejecting claims 4-5 and 9 the Office Action relies on *Kim* (U.S. Pub. No. 2005/0165613). Enclosed herein to moot the *Kim* reference is a certified English translation of Applicant's Japanese patent application filed on October 17, 2002.

Applicant's invention improves the accuracy of database searches particularly for complex databases such as patent databases. A user searches for files in the database by entering at least one search condition in a search field. The search conditions are used to query a database of files having search keys for a plurality of fields. The database query returns relevant files as well as the frequently used search keys for one or more search fields. A user then may select the most appropriate search keys. The search keys are added to the search conditions and a new database query is executed.

The search keys provide a useful tool for users of complex databases. For example, the Japanese patent search system has many search fields including data type (patent, design patent, or trademark), international patent classification (over 65,000 different types of patents), file index (a subclass of the IPC), and File Forming Term (FFT) (over 200,000 different terms). Non-expert searchers are often unfamiliar with these search fields and the user will frequently use only keywords to search the database. A keyword search is imprecise and often the database will respond to the query with a large number of "hits". The large number of hits makes it difficult if not impossible for the user to find the appropriate data file. Applicant's invention returns not only the files that match the keyword search but also the frequently used search keys for that file. The user then may select one or more of the search keys to appropriately refine the search.

Claim 11 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 11 has been amended to recite the computer program is embodied on a "computer readable storage medium". Accordingly, Applicant respectfully requests this rejection be withdrawn.

Claims 1-3 and 10-11 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Macke et al.* (U.S. Pat No 6,249,784). The claims have been amended to further distinguish over *Macke*. Applicant requests reconsideration in light of the amendments herein.

*Macke* discloses a system and method for processing, searching and performing in context searches on databases, (Abstract, Line 1). A search module accepts three inputs, a hit list 8, a list of search keys 9, and a test function, (*Macke*, Column 6, Lines 57-63). An extract module is used to extract and display actual data from the hits list, (*Macke*, Column 8, Lines 21-22). The user then may edit the data to perform a subsequent data base search (*Macke*, Column 8, Lines 25-28).

Claims 1-3 and 10-11 now recite an extracting unit (step) to extract a plurality of frequently-used search keys for each of the fields, (Application, Page 23, Lines 7-21). Claims 1-3 and 10-11 also recite a searching unit (step) that includes a displaying unit (step) to display unit to display the search keys, a selection unit (step) to select at least one search key, and a selective selection searching unit (step) operable to add the selected search key to a search query, (Application, Figure 2, elements 43,46,47). The recited extracting unit and searching unit are not disclosed or suggested by *Macke*. A user of *Macke*'s device must parse through the search results and select particular keywords to perform a subsequent search, (Macke, Column 8, Lines 27-28). In contrast, a user of the invention recited in claim 1 has the frequently used search keys for each of the plurality of fields conveniently displayed on the display unit.

This feature is important for searching complex databases such as a patent database. The database searcher is often unfamiliar with many of the search keys for the search fields, for example the international patent class in a patent database. To have the frequently used search keys listed in their appropriate fields, such as the international patent class, helps the user to narrow the scope of the subsequent search.

Claims 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Macke* in view of *Kim* (U.S. Pub. No. 2005/0165613). Claims 4-5 are cancelled herein.

Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Macke* in view of *Jin Kwan Kim et al.* (U.S. Pub. No. 2002/0143760).

*Kim et al* discloses a method for analyzing intellectual property information, (*Kim et al* , Abstract). The intellectual property information includes, patent publishing offices, international patent classifications, filing number, filing date, publication number and date, public notice number and date, priority number, inventor, applicant, abstract and invention number (*Kim et al*, Paragraph 51).

Claims 6-7 depend from claim 1 making them patentable for the same reasons as claim 1. *Kim et al* also fails to disclose the recited extracting unit and searching unit making claim 8 patentable over any combination of *Macke* and *Kim et al..*

Claims 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Macke* in view of *Ohga* (U.S. Pub. No. 2005/0165613).

*Ohga* discloses an apparatus and method of displaying the multi-viewpoint F-Terms with the titles Japanese patent application, (*Ohga*, Figure 1, Paragraph 3, 10). The F-Terms are displayed with their titles and their hierarchical patent classifications, (Olga, Claims 1 and 5).

Claim 8 depends from claim 1 making them patentable for the same reasons as claim 1. *Ohga* also fails to disclose the recited extracting unit and searching unit making claim 8 patentable over any combination of *Macke* and *Ohga*.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Macke* in view of *Kim* in further view of *Ohga* (U.S. Pub. No. 2005/0165613). Applicant assumes the Kim referred to in the Office Action is the now mooted *Kim* (U.S. Pat. No. 2005/0165613) reference, (Office Action, Page 14, Lines 11-13). If this assumption is incorrect, Applicant requests another opportunity to respond to this rejection.

The Office Action asserts that claim 9 is rejected for the same reasons as claims 6-8, (Office Action, Page 14, Lines 15-17). The Office action provides no further analysis. Applicant believes claims 6-8 are now in condition for allowance and accordingly submits that claim 9 is also. Applicant respectfully requests that if the Examiner finds otherwise that an analysis be provided so that the Applicant may properly respond.

Newly drafted, claim 12 recites a network embodiment of the invention, (Application, Figure 1). This embodiment includes the undisclosed extracting step and searching making claim 12 patentable as well. Newly drafted claim 13 depends from claim 1 and is patentable for the same reasons as claim 1.

Newly drafted claims 14 and 15 recite features not disclosed in *Macke*. In particular, the claims recite a selective searching unit operable to automatically add the search keys extracted in the selective extraction unit to the query so as to create a new search query, (Application, Page 34, Lines 23-25).

Claims 16 -20 also recite features not disclosed in *Macke*. Claim 16 recites a database 10, a search result display unit 48, a search key display unit 46, and a search key selecting unit
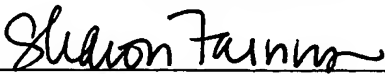
47. The search key display unit displays only the frequently found search keys found in the search. This provides the user with a hybrid search narrowing process. The search key display unit narrows the possible choices of subsequent searches by displaying only the most frequently found search terms. The user further narrows the search by selecting appropriate search keys. As explained above, a user of *Macke's* device must parse the database file to find appropriate search terms.

Claim 17 recites an embodiment wherein the search key display unit also displays the hit ratio, (Application, Figure 7B). In this embodiment, the user has even more information to make a decision on how to refine the database search. Claims 18-20 recite particular embodiments of claim 16, (Application, Figure 7B).

It is believed that the present case is now in condition for allowance and early notification of the same is requested.

If the Examiner believes a telephone interview would be appropriate, the undersigned attorney can be contacted at the listed phone number.
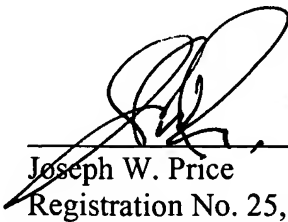
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 1, 2006.

By: _____ Sharon Farnus _____

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Signature·

Dated: September 1, 2006

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